



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

QUIGLEY *et al.*

Appl. No.: 09/710,238

Filed: November 9, 2000

For: **Pre-Equalization Technique For
Upstream Communication
Between Cable Modem And
Headend**

Confirmation No.: 4904

Art Unit: 2667

Examiner: Boakye, A.

Atty. Docket: 1875.132000G (as amended)

Supplemental Information Disclosure Statement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

Applicants have checked the appropriate boxes below.

- ☐ 1. Statement under 37 C.F.R. 1.704(d). Each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart application and this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of this information disclosure statement.
- ☒ 2. Filing under 37 C.F.R. § 1.97(b). This Information Disclosure Statement is being filed within three months of the date of filing of a national application other than a continued prosecution application (CPA), OR within three months of the date of entry of the national stage as set forth in 37 C.F.R. § 1.491 in an international application, OR before the mailing date of a first Office Action on the merits OR **before the mailing of a first Office Action after the filing of a request for continued examination under 37 C.F.R. § 1.114.** No statement or fee is required.
- ☐ 3. Filing under 37 C.F.R. § 1.97(c). This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing

date of a Final Rejection, or Notice of Allowance, or an action that otherwise closes prosecution in the application.

- ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- ☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).
- ☐ c. Attached is our PTO-2038 Credit Card Payment Form in the amount of \$_____ in payment of the fee under 37 C.F.R. § 1.17(p).
- ☐ 4. Filing under 37 C.F.R. § 1.97(d) This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection or Notice of Allowance, but before payment of the Issue Fee. Enclosed find our PTO-2038 Credit Card Payment Form in

the amount of \$_____ in payment of the fee under 37 C.F.R. § 1.17(p); in addition:

- ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- ☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).
- ☐ 5. The document(s) was/were cited in a search report by a foreign patent office in a counterpart foreign application. Submission of an English language version of the search report that indicates the degree of relevance found by the foreign office is provided in satisfaction of the requirement for a concise explanation of relevance. 1138 OG 37, 38.
- ☐ 6. A concise explanation of the relevance of the non-English language document(s) appears below:

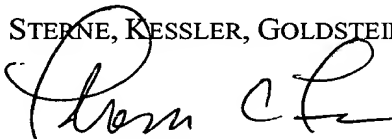
- ☒ 7. Copies of document AS1 and AT1 are submitted herewith. Document AS1 is a copy of an Office Action for U.S. Patent Application No. 09/430,821, mailed August 5, 2004, rejecting all pending claims. U.S. Patent Application No. 09/430,821 is relied upon for an earlier filing date under 35 U.S.C. § 120, and contains an identical claim set to the instant application. Applicants will not be filing a Reply to the Office Action, thereby abandoning the parent case. Thus, Applicants filed a request for continued examination in the instant application so that that the Examiner may properly consider the references cited in the Office Action in the parent case.
- ☒ 8. A copy of document AR1 (including Exhibits 1-5) was submitted to the Office in an IDS that complies with 37 C.F.R. § 1.98(a)-(c) in Application No. 09/430,821, filed October 29, 1999, which is relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, a copy of this document is not attached. 37 C.F.R. § 1.98(d).
- ☒ 9. In accordance with 37 C.F.R. § 1.98(a)(2), no copies of U.S. patents and patent application publications cited on the attached Form PTO-1449 are submitted.
- ☒ 10. It is expected that the examiner will review the prosecution and cited art in the parent application no(s). 09/574,558, filed May 19, 2000, and 09/430,821, filed October 29, 1999, in accordance with MPEP 2001.06(b), and indicate in the next communication from the office that the art cited in the earlier prosecution history has been reviewed in connection with the present application.

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

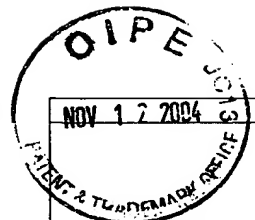


Thomas C. Fiala
Attorney for Applicants
Registration No. 43,610

Date: 11/12/04

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

333054-1.DOC



NOV 12 2004

Page 1 of 1

FORM PTO-1449

INFORMATION DISCLOSURE STATEMENT

ATTY. DOCKET NO.
1875.132000G (as amended)APPLICATION NO.
09/710,238FIRST NAMED INVENTOR
QUIGLEY et al.FILING DATE
November 9, 2000ART UNIT
2667

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA1	5,881,363	03/1999	Ghosh et al.			
	AB1	6,005,854	12/1999	Xu et al.			
	AC1	6,137,793	10/2000	Gorman et al.			
	AD1	6,298,098 B1	10/2001	Krasner et al.			
	AE1	6,353,604	03/2002	Grimwood et al.			
	AF1	6,647,069	11/2003	Segal et al.			
	AG1	6,647,070 B1	11/2003	Shalvi et al.			
	AH1						
	AI1						
	AJ1						
	AK1						

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL1						Yes No
	AM1						Yes No
	AN1						Yes No
	AO1						Yes No
	AP1						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>1</u>	Declaration of Lisa V. Denney, dated March 22, 2004, (8 pages) with Exhibits 1-5.
	AS	<u>1</u>	Copy of an Office Action for U.S. Patent Application No. 09/430,821, mailed August 5, 2004, 25 pages.
	AT	<u>1</u>	Franks, Lewis E., "Evaluation of the Effects of Notch Filters on Digital Data Transmission," <i>IEEE Transactions on Communication Technology</i> , pp. 447-449 (August 1970).

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

333105_1.DOC

SKGF Rev. 12/03/03

The PTO did not receive the following
listed items(s) Cit# AR